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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,461	09/19/2006	Peter Herold	2006_1381A	8997
513 7590 06/29/2009 WENDEROTH, LIND & PONACK, L.L.P. 1030 15th Street, N.W., Suite 400 East Washington, DC 20005-1503				
EXAMINER SHIAO, REI TSANG				
ART UNIT		PAPER NUMBER		
1626				
MAIL DATE		DELIVERY MODE		
06/29/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/593,461

Applicant(s)

HEROLD ET AL.

Examiner

REI-TSANG SHIAO

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

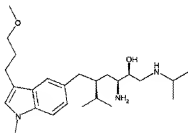
- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This application claims benefit of the foreign applications:
SWITZERLAND 00479/04 with a filing date 03/19/2004.
2. Amendment of claims 1-7, 9 and 12, cancellation of claim 8 in the amendment filed on May 04, 2009 is acknowledged. Claims 1-7 and 9-12 are pending in the application.

Responses to Election/Restriction

3. Applicant's election with traverse of election of Group III claims 1-12, in part, in the reply filed on August 29, 2008 is acknowledged. Election of the compound of



Example 3A, i.e., _____, as the single species is also acknowledged. Claims 1-7 and 9-12 are pending in the application. The scope of the invention of the elected subject matter is as follows.

Claims 1-7 and 9-12, in part, drawn to compounds/compositions of formula (I), wherein the variable R₆ represents indole or naphthalene, pyridyl or quinolinyl thereof, and when R₁ and R₂ and the nitrogen atom to which they are bonded form a heterocycle ring piperidine thereof, and methods of use.

The claims 1-7 and 9-12 herein lack unity of invention under PCT rule 13.1 and 13.2 since the compounds defined in the claims lack a significant structural element

qualifying as the special technical feature that defines a contribution over the prior art, see *TenBrink et al.* US 7,312,360.

Claims 1-7 and 9-12, in part, embraced in above elected subject matter, are prosecuted in the case. Claims 1-7 and 9-12, in part, not embraced in above elected subject matter, are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

The requirement is still deemed proper and therefore is made FINAL.

Responses to Amendment/Arguments

4. The rejection of claim 12 under 35 U.S.C. 112, first paragraph has been overcome in the amendment filed on May 04, 2009. Since claim 8 has been canceled, the rejection of claim 8 under 35 U.S.C. 112, first paragraph has been obviated herein.

5. Applicant's arguments regarding the rejection of claims 1-7 and 9-12 under 35 U.S.C. 103(a) over *TenBrink et al.* US 7,312,360 filed on May 04, 2009 have been fully considered but they are not persuasive. *TenBrink et al.* '360 disclose similar instant compounds of formula (I) without disclosing a single species. It is well-established that consideration of a reference (i.e., *TenBrink et al.* '360) is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches, when viewed in light of the admitted knowledge in the art, to person of ordinary skill in the art, see *in re Boe*, 355 F.2d 961, 148 USPQ 507, 510 (CCPA 1966); *in re Lamberti*, 545 F.2d 747, 750, 192 USPQ 279, 280 (CCPA 1976).

Therefore the rejection of claims 1-7 and 9-12 under 35 U.S.C. 103(a) over TenBrink et al. US 7,312,360 is maintained. Since claim 8 has been canceled, the rejection of claim 8 under 35 U.S.C. 103(a) has been obviated herein.

6. Since terminal disclaimers against co-pending application No. 11/522,316, 11/488,854 or 10/586,814 have not been filed to the Office, the provisional rejection of claims 1-7 and 9-12 under the obviousness-type double patenting is maintained. Applicants are requested to file terminal disclaimer to overcome the rejection. Since claim 8 has been canceled, the rejection of claim 8 under the obviousness-type double patenting has been obviated herein.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 and 9-12 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, page 6, lines 26-27, recites the limitation "which on in vivo application...non-radioactive isotopes" is indefinite or ambiguous. It is unclear what the scope of "prodrug" by this in vivo application is. Deletion of the limitation "which on in vivo application...non-radioactive isotopes" would obviate the rejection. Dependent claims 2-7 and 9-12 are also rejected along with claim 1 under 35 U.S.C. 112, second paragraph.

Claims Objection

8. Claims 1-7 and 9-12 are objected to as containing non-elected subject matter, i.e., heteroaryl, heterocycle, benzofuranyl, pyrimidyl, benzoimidazole, tetrazole, etc. It is suggested that applicants amend the claims to the scope of the elected subject matter as defined on the pages 2-3 *supra*.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rei-tsang Shiao whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph

K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/REI-TSANG SHIAO /

Rei-tsang Shiao, Ph.D.
Primary Examiner
Art Unit 1626

June 25, 2009